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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Satoshi AOYAMA et al.

Group Art Unit: 1795

Application No.: 10/581,394

Examiner: A. MARTIN

Filed: June 2, 2006

Docket No.: 128094

For: FUEL CELL MANUFACTURING METHOD AND FUEL CELL

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the May 30, 2008 Election of Species Requirement, Applicants provisionally elect Species III, claims 1, 6-9 and 20, with traverse. Furthermore, Applicants respectfully submit that at least independent claim 1 is generic to all Species.

Applicants respectfully submit that there exists *a priori* unity of invention with respect to claims 1-21, by virtue of the fact that claims 2-21 variously depend from claim 1. As stated in Chapter 10.06 of the ISPE (*International Search and Preliminary Examination Guidelines*):

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of one or more other claims and contains a reference, preferably at the beginning, to the other claim or claims and then states the additional features claimed (Rule 6.4).

Therefore, each dependent claim shares at least each element or technical feature of independent claim 1. ISPE 10.07 further provides:

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.

Thus, for the present application, a lack of unity of invention may only be determined *a posteriori*, or in other words, after a search of the prior art has been conducted and it is established that all the elements of the independent claim are known. *See* ISPE 10.07 and 10.08.

Therefore, the Office Action does not establish that each and every element of independent claim 1 is known in the prior art. Therefore, Applicants respectfully submit that lack of unity of invention has not been established, and thus a restriction requirement at this time is improper.

Applicants also strongly traverse this Election of Species Requirement since it is contrary to PCT rules. For example, Article 27 of the Patent Corporation Treaty requires that: "no national law shall require compliance with requirements relating to the form or contents of the international application different from or in addition to those which are provided for in this Treaty and the regulations."

Further, PCT Rule 13 requires that claims which encompass one single general inventive concept be searched and examined in the same international application. For example, PCT Rule 13.1 states: "the international application shall relate to one invention or to a group of inventions so linked as to form a single general inventive concept."

Furthermore, PCT Rule 13.4 expressly states that: "subject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent claims claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention."

The Election of Species Requirement is a convention specific to U.S. National Patent Application Examination practice. PCT Rule 13.1 specifically contemplates the single examination of a group of inventions so linked as to form a single general inventive concept, and PCT Rule 13.4 specifically requires examination of species claims within a single general inventive concept. Nothing in the PCT or its rules permits issuing an Election of Species Requirement. Any United States practice (such an Election of Species Requirement) or interpretation of the rule which is different from or in addition to the unity of practice as delineated in PCT Unity Rules 13.1-13.4 is necessarily in violation of PCT Article 27. Species practice is not provided for under PCT Rules 13.1-13.4 and is contrary to PCT Article 27, and the present Election of Species Requirement is accordingly prohibited by Article 27.

The Examiner is respectfully requested to reconsider and withdraw the Election of Species Requirement and to examine all of the species and claims in this application.

Respectfully submitted,



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JAO:AAT/ccs

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